

REMARKS

Claims 1-27 are all the claims pending in the application. Applicants respectfully request that the Examiner acknowledge Applicants' claim for foreign priority, as well as acceptance of the drawings in the next Office Action.

Claim Rejections - 35 USC § 103(a)

Claims 1-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka et al. (U.S. Patent No. 6,526,396) in view of Yamada (U.S. Patent No. 6,373,100). The Examiner alleges that, as per claims 1, 6, 11, 16, 20 and 24, Hiratsuka et al. teach using personal authentication information for authenticating a member as member identification information and a password. The Examiner further states that this process is performed by a registration unit for registering physical characteristics of each member in advance; and a processing unit responsive to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at the registration unit to conduct authentication, and determining whether connection is allowed or not according to authentication results (citing the Abstract, and portions of column 3).

The Examiner correctly acknowledges that Hiratsuka et al. fail to teach a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network. Nonetheless, the Examiner states that Yamada teaches a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network (citing Figures 1-3, and column 1, lines 19-45). Thus, the

Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiratsuka et al's inventive concept to include the Yamada concept of a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network because this would have provided a system for shopping wherein a customer can order merchandise and designate addresses or places where the good or merchandise can be delivered. Applicants respectfully traverse this rejection.

Specifically, Applicants submit that the Examiner has not presented persuasive arguments necessary for a *prima facie* case of obviousness. Applicants note that most if not all inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

The purpose of the Yamada on-line shopping system is to be able to order a product, and then have the product delivered to a 24-hour convenience store 9 rather than the customer's

home so that a delivery is not missed (see Abstract). After ordering, the customer 3 can confirm via terminal equipment 3a that the product has been delivered to the convenience store 9. At the convenience store 9, the shop assistant verifies the customer identification information using an ID card against the information on the delivered package, and then releases the package to the customer (see col. 3, line 55 through col. 4, line 3). As such, the customer can get the package at any time from the convenience store, and the home deliverer never has to redeliver a package due to the customer not being home. Accordingly, the method disclosed by Yamada is based on a traditional package delivery service. There is *no suggestion* that actual physical characteristics be registered or processed, such as a finger print to provide identification of a customer as recited in the independent claims of the present application.

Applicants note that “defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *Exolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1363 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880 (Fed. Cir. 1998). “Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.* (citing *In re Beattie*, 974 F.2d 1309, 1311-12, (Fed. Cir. 1992)).

Applicants submit, based on the Examiner's reasons for combining the references, that the Examiner has improperly rejected the claims for at least three reasons. First, analogous to *Exolochem*, the Examiner has defined the problem in terms of the solution, revealing improper hindsight in the selection of the prior art relevant to obviousness. As stated above, there is no teaching or suggestion in the patents themselves of making this specific combination, specifically as the problem that Yamada solves is how to deliver a package so that a customer does not have to be at the delivery location when it is delivered. The present invention solves a different problem - that of controlling access to a mail-order site. The present invention solves this problem by using physical characteristics of a person as well as a password.

~~Second, and equally important, the Examiner states that the reason for combining the~~
references is to provide a system for shopping wherein the customer can order merchandise and designate addresses or places where the goods or merchandise can be delivered. Applicants fail to see how designating a place to deliver goods or merchandise, as taught by Yamada, would motivate one of ordinary skill in the art to incorporate its on-line shopping method into a personal identification apparatus (Hiratsuka et al.) as the Examiner concludes. Delivery of goods is quite different than controlling access to a mail-order site.

Finally, case law provides that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (see also MPEP 2143). For the reasons discussed above, the rejection is "hindsight reconstruction" since the *only*

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/825,333

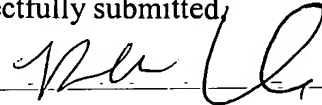
Attorney Docket No. Q63916

basis for achieving the claimed invention from the combination of Yamada and Hiratsuka et al., as proposed by the Examiner, would be impermissible hindsight reliance upon Applicants' own teaching in the present application.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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WASHINGTON OFFICE

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CUSTOMER NUMBER

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